

REMARKS

Claim 18 is canceled without prejudice, and therefore claims 10 and 12 to 17 are now pending in the present application.

Applicants thank the Examiner for acknowledging the claim for foreign priority and indicating that all certified copies of the priority documents have been received.

Applicants respectfully request that the Examiner acknowledge in the next Communication whether the Drawings are accepted.

It is respectfully requested that the present application be reconsidered since all of the presently pending claims are allowable.

Applicants thank the Examiner for allowing claims 10 and 12 to 17.

Claim 18 was rejected under 35 U.S.C. § 102(b) as anticipated by Sakata et al., JP 06-324074. Claim 18 was also rejected under 35 U.S.C. § 102(b) as anticipated by Benz et al., U.S. Patent No. 5,542,558.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Actions to date do not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As explained above, while the rejections may not be agreed with, to facilitate matters, claim 10 has been canceled without prejudice. It is therefore respectfully requested that the

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rejections be withdrawn. Applicants may file a divisional application as to the canceled claims.

Accordingly, claims 10 and 12 to 17 are allowed.

CONCLUSION

In view of the foregoing, all of pending claims 10 and 12 to 17 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,

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